

REMARKS

Claims 1-24 are pending in the application. Claims 1 and 13 are independent.

On March 5, 2003 the undersigned met with the Examiner and his supervisor. During the meeting, it was agreed that the amendment to be presented by fax on March 6, 2003 would put the claims in condition for allowance over the art of record. This amendment returns the claims to the way they read prior to the March 6, 2003 amendment.

Following the March 6, 2003 amendment, the Examiner found one new reference, i.e. Wynn et al. and, in Paper Number 9, rejected the claims which were previously agreed to be allowable. In response to Paper Number 9, the Applicant's attorneys filed remarks and spoke several times with the Examiner by telephone. After these discussions, the Examiner agreed to allow the claims if the Applicant filed the previously required terminal disclaimer. While the Applicant's attorneys were in the process of preparing a terminal disclaimer to fax to the Examiner, the Examiner called to say that he could not allow the claims because his supervisor instructed him not to allow the claims.

The undersigned then spoke by telephone with the Examiner's supervisor, Doug Olms. Examiner Olms agreed that the prior art

did not teach or suggest claims 1 or 13, but that the difference between claims 1 and 13 relative to the prior art was an obvious matter of design choice.

An "obvious matter of design choice" is not a statutory rejection. There is no law or rule regarding the grounds for making such a rejection. However, the MPEP instructs Examiners that "if the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may use the rationale used by the court." See MPEP §2144.04.

Although Examiner Olms did not refer to any particular legal decision having facts similar to the instant application, MPEP §2144.04 provides seven examples of when a claim may be considered *prima facie* obvious in view of a prior legal decision. These examples are: (1) aesthetic design change, (2) elimination of a step or an element and its function, (3) automating a manual activity, (4) change in size, shape, or sequence of adding ingredients, (5) making portable, integral, separable, adjustable, or continuous, (6) reversal, duplication, or rearrangement of parts, and (7) purifying an old product. None of these seven examples immediately suggests the facts of the present application. However, the discussion of the sixth example provides some insight relevant to the instant rejection.

The Applicant has argued that the heart of the rejected claims is that requests made in one row are for space in the very next row and not for any other row. Thus, requests are granted in time for the space in the next row to be used by the requester. None of the prior art of record teach or suggests this. It might appear that Examiner Olms considers this feature of the claims to be a "rearrangement of parts". The MPEP provides a discussion of three cases on this point:

"In re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950) (Claims to a hydraulic power press which read on the prior art except with regard to the position of the starting switch were held unpatentable because shifting the position of the starting switch would not have modified the operation of the device.); In re Kuhle, 526 F.2d 553, 188 USPQ 7 (CCPA 1975) (the particular placement of a contact in a conductivity measuring device was held to be an obvious matter of design choice). However, 'The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device.' Ex parte Chicago Rawhide Mfg. Co., 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984)." MPEP §2144.04(VI).

It is respectfully submitted that the art of record does not provide any incentive to have requests made in row N for space in row N+1. The prior art shows requests made for space when it becomes available and requests made for space in the next frame, but not for space in the next row of the same frame. The reason why the prior art does not provide any incentive to make requests

in one row for space in the very next row is that, prior to the present invention, it could not be done. Thus, under the rule of Ex parte Chicago Rawhide Mfg. Co., the claims of the instant application are not *prima facie* obvious.

Since the previous amendment of claims 1 and 13 was only made as a token because the Examiner agreed to allow the claims, that amendment is reversed herein. The Applicant believes that the claims as filed are allowable over the art and only made the amendment to expedite allowance. Since this application will have to go to appeal, the Applicant chooses to have the Board review the rejection of the claims as filed.

In light of all of the above, it is submitted that the claims are in order for allowance, and prompt allowance is earnestly requested. If the Examiner disagrees that the claims are in order for allowance, it is requested that he promptly issue a final rejection so that the rejection can be appealed as soon as possible.

Respectfully submitted,


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